

REMARKS

A request for continued examination was filed in this application on September 29, 2006. The request and associated submissions were accepted and entered by the Office, as indicated in the Office Action dated December 12, 2006. Applicant thanks the Office for entering the request and the associated submissions.

This application presently contains claims 1, 3, 5-11 and 30-72. By the present Amendment and Response, Claims 1 and 3 have been amended. Support for the amendments can be found throughout the specification, *e.g.*, Specification at p. 5, lines 20-26; p. 10, lines 17-20; Figure 1; and the claims as filed. No new matter is added by these amendments. Applicant respectfully requests entry of the foregoing amendments.

Rejections under 35 U.S.C. § 103

Claims 1, 3, 5-11 and 30-72 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over Uijtewaal *et al.*, EP 0416572 A1, Leone *et al.*, Nucl. Acids Res. 26:2150-2155 (1998) and Heid *et al.*, Genome Research, 6:986-994 (1996). *See* Office Action mailed December 12, 2006 at pages 2-6. The Office alleges that Uijtewaal *et al.* teach an oligonucleotide probe containing motif B (5'-CTGATGA-3'), Office Action at page 2, and that because "all probe are capable of being released from their target sequences by increased the hybridization temperature or solution conditions, the probe of Uijtewaal *et al.* inherently anticipates [the] limitation" of being "capable of being released from the target" nucleic acid molecule. Office Action at 2-3; *see, e.g.*, Claim 1. Furthermore, the Office alleges that "[i]t would have been *prima facie* obvious to one of ordinary skill in the art to have used the real-time detection methods of Leone *et al.* and Heid *et al.* to detect ribozymes in transfected plants of Uijtewaal." Office Action at page 5. The Office further alleges that motivation to combine these references is provided in Leone *et al.* (page 2155, last paragraph) and Heid *et al.* (page 992, first and second paragraphs). Office Action at pages 5-6. Applicant respectfully disagrees with the Office's allegations.

The Applicant disagrees that the Examiner has established a *prima facie* case of obviousness.¹ Moreover, the cited references, even when combined, do not teach or suggest “a primer to which a nucleic acid sequence is attached, which codes for the sequence motif 5'-GAAA-3' (motif A”) in the transcript” for nucleic acid amplification (*see, e.g.*, Claims 1 and 3) or a nucleic acid probe that “is capable of being released from a target nucleic acid molecule by cleavage of a ribozyme.” *See id.*

A *prima facie* case of obviousness requires that the prior art reference, or references, when combined, teaches or suggests all of the claim limitations. Whatever else Uijtewaal *et al.*, Leone *et al.*, and Heid *et al.* teach or suggest, these references alone or in combination do not teach or suggest the processes of claims 1 or 3. At the very least, Uijtewaal *et al.*, Leone *et al.*, and Heid *et al.* do not teach or suggest “using a primer to which a nucleic acid sequence is attached, which codes for the sequence motif 5'-GAAA-3' (motif A) in the transcript” for nucleic acid amplification. Likewise, none of Uijtewaal *et al.*, Leone *et al.*, and Heid *et al.* teaches or suggests “carrying out the amplification in the presence of an excess of a nucleic acid probe, which contains the sequence motif 5'-CUGANGA-3' (motif B) and is capable of being released from a target nucleic acid molecule by cleavage of a ribozyme” *See, e.g.*, Claims 1 and 3.

As such, Applicant respectfully requests withdrawal of the rejections of claims 1, 3, 5-11 and 30-72 under 35 U.S.C. § 103(a) for purported unpatentability over Uijtewaal *et al.*, Leone *et al.*, and Heid *et al.*

¹ *See* Applicant's Amendment and Response filed July 20, 2006, the arguments of which are hereby incorporated by reference as if fully set forth herein.

CONCLUSION

The presently pending claims are believed to be in condition for immediate allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. The Examiner is respectfully requested to contact Applicant's undersigned representative at 202.942.5055 to address any unresolved issues remaining in this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'DM' or similar initials, written in a cursive style.

David R. Marsh (Reg. No. 41,408)

Lisa A. Adelson (Reg. No. 51,204)

Zhiqiang Zhao (Reg. No. L0117)

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ARNOLD & PORTER LLP
Attn: IP Docketing
555 Twelfth Street, N.W.
Washington, D.C. 20004-1206
(202) 942-5000 telephone
(202) 942-5999 facsimile